

REMARKS

Applicant's counsel thanks the Examiner for the careful consideration given the application. Applicant's counsel also thanks the Examiner for the allowance of claims 5-7, 10-20 and 27-33. Only 5 claims still remain rejected, these being claims 1, 2, 4, 8 and 35. With regard to claim 35, it has now been amended so that it essentially covers the same subject matter as claim 12, which has been previously allowed. Since claim 12 was allowed, claim 35 as now presented should also be allowed.

In the present Amendment claims 3 and 35 have been amended and new claims 36 and 37 have been added. Support for the amendment to claim 3 can be found, for example, in Figs. 2 and 4. Support for new claim 36 can be found in Fig. 13. Support for new claim 37 can be found in Figs. 2 and 4.

Applicant's counsel also thanks the Examiner for the courteous telephone interview conducted on September 28, 2005 during which the independent claims and also the subject matter of present claims 3, 36 and 37 were discussed. The Examiner agreed that the subject matter of claims 3, 36 and 37 defined over the applied references but the Examiner mentioned the potential applicability of US 4,441,279. Applicant's counsel thanks the Examiner for the constructive suggestions she made regarding future prosecution of this case, which are set forth in the Interview Summary. The substance of the Interview Summary is incorporated herein by reference.

Other than claim 35 (allowable for the reasons set forth above), the only other independent claims which stand rejected are claims 1, 4 and 8. A key feature of all these claims is that the guide rod is infinitely adjustable. The Examiner and applicant's counsel both agree that Owen U.S. 4,731,953 does not teach an infinitely adjustable guide rod. Rather, Owen teaches a guide rod 32, 32' in Fig. 4 which is adjustable in discrete increments via a locking pin 34 as shown in Fig. 5. Claim 1 as presently presented requires that the infinitely adjustable guide rod includes an element which bears nonuniformly against a side of the guide rod. Claim 8 has a similar limitation. The Examiner's position is that these structures are obvious over Owen in view of Tschopp, 3,417,356, Towfigh, 4,791,873 or Rath, 5,598,996. The Examiner states in her most recent Office action as follows:

"Owen does not disclose that the guide rod is infinitely adjustable or that the element bears nonuniformly against the rod. Either Tschopp, Towfigh or Rath, in devices requiring linear adjustment, teach providing that adjustment through an infinitely adjustable linear part that is locked in place by an element that bears nonuniformly against a side of the part. See Tschopp, figures 1 and 2 and their descriptions; Towfigh, see figures 1 and 2, their descriptions, and especially the description of the upper yoke and set screw 60; and Rath, figures 1 and 8 and their descriptions. It would have been obvious to one of ordinary skill in the art to have made the guide rod of Owen infinitely adjustable with an element that bears nonuniformly against a side of the rod to lock it in position as taught by either Tschopp, Towfigh or Rath, to allow the rod to be positioned and finely adjusted anywhere within rod holder as desired, allowing the sharpener to be used to sharpen any knife edge at an infinite variety of bevel angles".

Respectfully, the above-quoted motivation to combine Owen with the secondary references cited by the Examiner is based entirely on hindsight reconstruction in view of the present Longbrake patent application, and therefore the rejection of the claims under Section 103 is improper. As will be discussed in more detail below, the only way that one would ever be motivated to combine the knife sharpener apparatus of Owen with the magnets of Tschopp or the desk-top of Towfigh or the target stand of Rath would be to read and understand the present disclosure of Longbrake. Via Longbrake is the only way these prior references can be connected or combined. However, to use Longbrake to connect the prior art references is pure hindsight reconstruction, which is not proper and is not at all permitted.

"Obviousness can only be established by combining ... the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP Sec. 2143.01. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP Sec. 2143.01. This is well-explained in *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). In the present case, neither Owen nor any of the secondary references provides any teaching, suggestion or motivation to combine the references (discussed fully below), nor has the Examiner provided any basis to support the combination, other than through hindsight reconstruction and the explicit teachings of the present Longbrake disclosure. MPEP Sec. 2143.01 states that "The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art...". That standard of obviousness has not been met in the present case.

Owen teaches a guide rod 32 in a sleeve 28 which is adjustable in discrete increments by use of a locking pin 34. Nowhere does it suggest or teach or mention making the guide rod infinitely adjustable, nor does it suggest the desirability of making it infinitely adjustable, nor does it mention or suggest anywhere using a set screw to achieve infinite adjustability. Accordingly, Owen nowhere teaches or suggests or motivates one to make the guide rod infinitely adjustable, using a set screw or anything else. Turning to the three secondary references, Tschopp merely mentions the use of a set screw to locate hollow cylinders in different positions around the opposed poles of a magnet to permit correction of the field gradient at the edge of the magnetic field in the air gap between the poles. Nowhere in Tschopp is it

disclosed or even remotely suggested to modify the construction of a guide rod in a knife sharpening apparatus. In a similar manner, Towfigh teaches a knob 60 which may be tightened in different positions to provide a stop to interrupt the movement of a board or desk-top 26. However, nowhere in Towfigh is it disclosed or even remotely suggested that the knob 60 or set screw 58 associated therewith may be used in combination with a guide rod in a knife sharpening apparatus. Finally, Rath teaches in Fig. 8 a set screw 8 which can be tightened to maintain the position of upright 3 along a crossbar 2 in a target stand such as an archery target stand. However, nowhere in Rath is it disclosed or even remotely suggested to combine this technology with a guide rod of a knife sharpening apparatus.

In summary, neither Owen nor any of the secondary references discloses any reason or provides any basis or motivation to look to the other reference(s) to supplement the structures taught therein. Specifically, Owen does not teach or suggest the use of a set screw to provide for infinite adjustability of the guide rod, and neither Tschopp, Towfigh or Rath teaches or suggests the need or desirability of taking a set screw structure in a magnetic field or a desk-top or a target stand and incorporating it into a guide rod in a knife sharpening apparatus. The only teaching or suggestion to combine these features comes from the present Longbrake disclosure; Longbrake is the only one who has suggested and taught the use of a set screw to make a guide rod in a knife sharpening apparatus infinitely adjustable. In other words, the only teaching or suggestion to make the combination comes from applicant's own patent application, and it cannot be found in any of the references themselves and accordingly the only way the combination can be defended is through hindsight reconstruction, which is not permitted. Clearly, without access to the Longbrake disclosure, no one would ever have thought to combine the teaching of Owen with the secondary teachings relating to the magnets, adjustable desk-tops and target stands of the secondary references.

In summary, the primary reference Owen does not teach or suggest to use a set screw to make the guide rod infinitely adjustable, and none of the secondary references either discloses or even remotely suggests to use a set screw in combination with a guide rod in a knife sharpening apparatus to make the guide rod infinitely adjustable. For these reasons, the Section 103 obviousness combination cannot be sustained.

It is also submitted that a person of ordinary skill in the art, in Longbrake's position, would not look to teachings in the fields of magnets, adjustable desk-tops, and target stands when one is seeking to improve upon prior art knife sharpening apparatuses. Longbrake's goal was to invent a better knife sharpener; his goal was not to provide a better magnet or a better desk-top or a better target stand. In trying to provide an improved knife sharpener, one of ordinary skill in the art would direct his attention to prior patents and teachings in the knife sharpener field to see what could be learned there. The person of ordinary skill in the art would not be motivated to look at the magnet art or desk-top art or target stand art when his goal was to invent a better knife sharpener. For these reasons, it is not proper to combine

Tschopp, Towfigh or Rath with the primary Owen reference. See, for example, *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992), which is discussed in MPEP Sec. 2141.01(a) (Applicant claimed an improvement in a hose clamp which differed from the prior art in the presence of a preassembly "hook" which maintained the preassembly condition of the clamp and disengaged automatically when the clamp was tightened. The Board relied upon a reference which disclosed a hook and eye fastener for use in garments, reasoning that all hooking problems are analogous. The court held the reference was not within the field of applicant's endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments.)

Just as in *Oetiker*, where it was held that a person with ordinary skill in the art would not be motivated to look to fasteners for garments in order to solve a problem of fastening a hose clamp, even more so in our case a person trying to improve a knife sharpener would not look to magnets or adjustable desk-tops or target stands. Any such combination requires hindsight based upon the Longbrake disclosure, which is impermissible.

For all the foregoing reasons, it is clear that it is not proper to combine the secondary references with the primary reference in order to assert that applicant's claims 1, 2, 4 and 8 are obvious. Since there is no teaching, suggestion or motivation to make the combination, it is clear that the Section 103 rejection should be reconsidered and the respective claims should be allowed.

Applicant's counsel sincerely believes that Longbrake is entitled to a patent on the independent claims as they are now set forth. Longbrake's invention truly is a significant improvement over the prior art. The Examiner has conducted a very thorough and skillful search of the prior art and the applied reference merely teaches a guide rod adjustable in discrete increments. Longbrake's invention of an infinitely adjustable guide rod as claimed in claim 1 simply is not found or suggested in the prior art. It is respectfully submitted that applicant is not being at all unreasonable in requesting that a patent be granted on the infinitely adjustable guide rod as set forth in the independent claims.

For all the foregoing reasons, it is believed that the Longbrake application is now in condition for allowance, which is respectfully requested.

If any further fees are required by this communication, please charge such fees to our Deposit Account No. 16-0820, Order No. 35457.

Respectfully submitted,

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